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08/439,562

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/439,562 05/11/95 RESPONSE

FCM1/0131

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EXAMINER

ART UNIT	PAPER NUMBER
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5302

8

DATE MAILED:

01/31/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 5/11/95 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 3 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 63-76 are pending in the application.
Of the above, claims 74-76 are withdrawn from consideration.
2. ☒ Claims 1-62 and 77-100 have been cancelled.
3. ☐ Claims are allowed.
4. ☒ Claims 63-73 are rejected.
5. ☐ Claims are objected to.
6. ☐ Claims are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on . Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on , has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed , has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. ; filed on .
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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1. In response to the Preliminary Amendment filed on May 11, 1995, claims 1-62 and 77-100 have been canceled and claims 63-76 are pending. In addition, applicant is informed that the "search result" (Exhibit A and B) in the information disclosure statement (IDS) filed May 11, 1995 have been considered solely as the content of the printed pages. Further, the information disclosure statement filed November 6, 1995 fails to comply with the provisions of MPEP 609 because applicant fails to include a concise statement of the relevance of the following non-English language references listed, as required under 37 C.F.R.

§1.98(a)(3): Japanese Patent No. 61-137797, 63-213016 and 4-104699. It has been placed in the application file, but the information referred to therein has not been considered as to the merits.

2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 63-73 are drawn to the method for starting up a process in a host device, classified in Class 364, subclass 138.

II. Claims 74-76 are drawn to the host device, classified in Class 364, subclass 400.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are prima facie independent and distinct

inventions. Invention I is directed to the method for starting up a process in the host device by booting the operating system. Invention II is directed to the structure of the host device. Because these inventions are distinct for the reasons given above and has acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Omkar Suryadevara (applicant's attorney, Reg. No. 36,320) on January 18, 1996 a provisional election was made without traverse to prosecute the invention of Group I, claims 63-73 as a prerequisite to the grant of special status. Hence, examination on the merits is proceed on claims 63-73 drawn to the elected invention. Claims 74-76 are withdrawn from further consideration by the Examiner as being drawn to a non-elected invention and is made **FINAL**. 37 C.F.R. § 1.142(b).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

6. The title of the invention is not descriptive. A new title

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is required that is clearly indicative of the invention to which the claims are directed.

7. The use of the trademark "MICROSOFT" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

8. The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the method steps of displaying a selection of the encoded electronic content on the removable storage media, inserting the removable storage media after the enabling step, disabling the interrupt prior to the step of executing, waiting for the interrupt subsequent to the step of starting up and executing the file of the predetermined name subsequent to the step of loading must be shown or the feature canceled from the claim. **No new matter** should be entered. Moreover, the drawings are also objected to by the Draftsman as being informal (see PTO-948). Correction is required. Applicant is required to submit a proposed drawing correction in response to this Office action.

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9. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention. The references for the claimed method steps of displaying a selection of the encoded electronic content on the removable storage media (as per claim 64), inserting the removable storage media after the enabling step (as per claim 69), disabling the interrupt prior to the step of executing (as per claim 71), waiting for the interrupt subsequent to the step of starting up (as per claim 72) and executing the file of the predetermined name subsequent to the step of loading (as per claim 73) are unclear. Further, the term "date 6-15-93," on Pg. 42, line 5 should be recited as --date 6-15-93, now U.S. Pat. No. 5,459,489,-- to clarify the status.

10. Claims 64, 69 and 71-73 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

11. Claims 64 and 68-72 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

As per claims 64, 68 and 71, the recitation therein is unclear and confusing. It is not understood as to what "the selection" is being referred to and how the selection is being displayed without any structural element of the display means (as per claim 64). It is also not understood as to which "executing step" (as per claims 68 and 71) is being referred to. Is it referred to the step of executing firmware from the read only memory, or the step of executing the initialization file, or the step of executing the file of the predetermined name in the removable storage media? In addition, as per claim 72, the antecedent basis for "said starting up" (as per claim 72) is lacking. Further, as per claims 68-71, the terms "said executing" (as per claims 68 and 71), "said enabling" (as per claim 69) and "said booting" (as per claim 70) should be respectively recited as --said step of executing--, --said step of enabling-- and --said step of booting--.

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed

publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 63-73 as best understood are rejected under 35 U.S.C. § 102(a) as being anticipated by Willman et al (U.S. Pat. No. 5,363,487).

As per claims 1-3, the broadly claimed structure can be broadly interpreted as the method and system for dynamic volume tracking in an installable file system of Willman et al. Figs. 1A-1B of Willman et al broadly discloses the method for starting up the process in the host device having powering up the host device (i.e. turn the power on), disabling the interrupt before executing firmware from the read only memory (106) and booting the operating system (i.e. MS-DOS 204 or OS/2 252) by executing the initialization file, enabling the interrupt and waiting the interrupt either by timer or from the removable peripheral devices (i.e floppy disk 116, CD-Rom 122 or tape 124), inserting the removable storage media in the peripheral device driver for checking a file of a predetermined name in the removable storage media, loading and executing the electronic content of the predetermined name file encoded in the removable storage media, and displaying the selection (see the abstract and from column 3, line 36 to column 31, line 21).

14. Claims 63-73 as best understood are also rejected under 35 U.S.C. § 102(b) as being anticipated by Ogawa et al (U.S. Pat. No. 4,716,543).

As per claims 1, 8, 11 and 18, the broadly claimed structure can also be broadly interpreted as the terminal device editing document and communicating data of Ogawa et al. The teaching of Ogawa et al broadly discloses the method for starting up the process in the host device having powering up the host device (i.e. turn the power on), disabling the interrupt before executing firmware from the read only memory (142, 144) and booting the operating system by executing the initialization file (OS), enabling the interrupt and waiting the interrupt either by timer (Figs. 30-33) or from the removable peripheral devices (i.e floppy disk 52, 54), inserting the removable storage media in the peripheral device driver for checking a file of a predetermined name in the removable storage media, loading and executing the electronic content of the predetermined name file encoded in the removable storage media, and displaying the selection (see from column 4, line 9 to column 31, line 9).

15. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification. In

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addition, the prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Washburn (U.S. Pat. No. 4,124,888) - note Figs. 1-40;

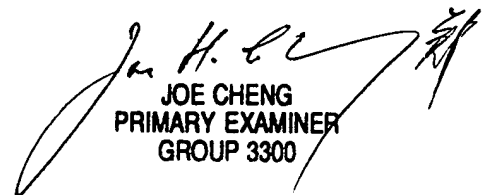
Whisler (U.S. Pat. No. 5,053,945) - note Figs. 1-3 and 8-16;

Getson, Jr. et al (U.S. Pat. No. 5,101,490) - note Figs. 1-

6.

16. Any inquiry concerning this communication should be directed to Joe Cheng at telephone number (703) 308-0858.

Joe Cheng
January 21, 1996


JOE CHENG
PRIMARY EXAMINER
GROUP 3300